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5681-90700/P6515

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/982,214  
Filed: October 17, 2001  
Inventors:  
Sridatta Viswanath  
Yafeng Li

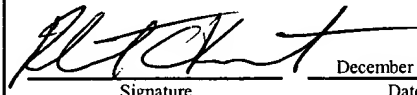
Title: Document Exchange  
Framework for Automated  
Extensible Markup  
Language Data in an E-  
Procurement System and  
Method

§ Examiner: Fischer, Andrew J.  
§ Group/Art Unit: 3627  
§ Atty. Dkt. No: 5681-90700  
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Printed Name



Signature

December 2, 2005  
Date

PETITION UNDER 37 CFR 1.144

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted as a petition under 37 CFR 1.144 from the restriction requirement made final in the Office Action dated November 7, 2005.

In the Office Action dated April 7, 2005, the Examiner presented a restriction requirement requiring election of one of the following two inventions *as defined by the Examiner*:

I. Claims 17-30, drawn to Document Exchange Framework and method of use, classified in class 707, subclass 523.

III. Claims 31-45, drawn to a method, device and computer accessible medium for processing purchasing requests including receiving and parsing documents with name tags, class 705, subclass 26.

Based on Applicants' election of Invention I in a prior restriction requirement, the Examiner deemed Invention III to be non-elected. In the Response filed July 11, 2005, Applicants traversed the restriction requirement made in the Office Action dated April 7, 2005 and presented reasons for traversal. In the Office Action dated November 7, 2005, the Examiner acknowledged Applicants' traversal; however, the Examiner maintained the restriction requirement. Applicants hereby petition for withdrawal of the restriction requirement for at least the following reasons.

Applicants traverse the restriction requirement between Inventions I and III on the grounds that the Examiner has not stated a proper restriction requirement.

The Examiner contends that Inventions I and III "are related as subcombinations disclosed as usable together in a single combination." **However, Inventions I and III are not disclosed as subcombinations usable together in a single combination.** Instead, the respective claims of Inventions I and III recite features and functionality of the same Document Exchange (XDOC) Framework, as disclosed in the application. Applicants' disclosure does not describe the features of claims 17-30 as one subcombination and the features of claims 31-45 as a second subcombination where the two different subcombinations are disclosed as usable together in a single combination. Although claims 17-30 and 31-45 do vary in scope, both claim sets read on the general functionality of the XDOC Framework described in Applicants' disclosure, not on two separate subcombinations.

Moreover, the Examiner's own definitions of Inventions I and III do not define separate subcombinations usable together in a single combination. The Examiner defines Invention I as a "Document Exchange Framework and method of use", and the Examiner defines Invention III as "a method, device and computer accessible medium for processing purchase requests including receiving and parsing documents with name tags." However, the functionality that the Examiner uses to define Invention III is described in Applicants' specification as part of the functionality of the Document

Exchange Framework that the Examiner uses to define Invention I. Thus, by the Examiner's own definitions, Inventions I and III are not separate subcombinations.

For example, Applicants' disclosure describes embodiments of the XDOC Framework including various components such as the configuration file module, a conduit file module and a persistent object framer module, recited in claim 17 (Invention I) (see, e.g. FIG. 6, and pages 21-22). Applicants' disclosure also describes embodiments of the XDOC Framework including functionality recited in claim 26 (Invention I), such as receiving a purchasing request, retrieving XML content from data sources, and transforming the retrieved XML content (see, e.g. FIG. 6, and pages 21-22). Additionally, Applicants' disclosure describes embodiments of the same XDOC Framework including functionality recited in claims 31, 36 and 41 (Invention III), such as receiving one or more input documents in a markup language, identifying tag names in the input documents, generating data objects corresponding to tag names, identifying purchasing parameters, and generating output documents (see, e.g. FIGs. 8A and 8B; pages 15-16; pages 24-25). Like original claims 17-30, added claims 31-45 read on the functionality of the same document exchange framework for processing in-bound and out-bound documents in an electronic procurement system as described in Applicants' specification. Although claims 17-30 and 31-45 certainly vary in scope, they do not reflect separate subcombinations.

**A proper restriction requirement under M.P.E.P. 806.05(d) requires that the subcombinations "do not overlap in scope".** As discussed above, there is clearly overlap in scope between the claims of group I and the claims of group III. Applicants are by no means asserting that the scope of the claims of group I is identical to the scope of the claims of group III. In fact there are clearly differences in scope between the claims. However, some of the claims of group I do have some overlap in scope with some of the claims of group III. As discussed above, both claim groups recite similar systems overlapping in scope, not separate subcombinations. Since, claims of group I have some overlap in scope with claims of group III, restriction cannot be required under M.P.E.P. 806.05(d). Therefore, the Examiner's restriction requirement is improper.

Furthermore, to state a proper restriction requirement for subcombinations usable together in a single combination, the Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. The burden is on the Examiner to provide a proper example. M.P.E.P. 806.05(d). The example given by the Examiner is that “invention III has separate utility such as it requires the use of tag names which are not required by invention I.” The Examiner has merely pointed out that the claims of Invention III include a limitation not included in the claims of Invention I. However, a difference in scope between the claims does not necessarily mean that they have a different utility. While not requiring the use of tag names, the claims of Invention I do not preclude the use of tag names either. In fact, Applicants’ specification clearly describes that the Document Exchange Framework and method of use, which the Examiner has defined as Invention I, can make use of tag names in certain embodiments (see, e.g. page 15, line 26 – page 16, line 18). Thus, rather than showing by way of example that one of the subcombinations has utility other than in the disclosed combination, the Examiner has merely pointed out a feature of the Document Exchange (XDOC) Framework that is recited in Invention III while not specifically recited in Invention I. According to M.P.E.P. 806.05(d), “the burden is on the examiner to document a viable alternative use or withdraw the requirement.” Since the Examiner has not documented a viable alternative use, the restriction requirement must be withdrawn.

Another shortcoming of the Examiner’s restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show “reasons why there would be a serious burden on the examiner if restriction is not required”. In regard to this requirement, the Examiner stated in the Office Action of April 7, 2005 that the inventions “have acquired a separate status in the art as shown by their different classification.” **However, the Examiner’s reliance of a different classification to show a separate status in the art and serious burden is misplaced because the purported classifications are clearly inaccurate and not separate for the two claim groups.** For example, the Examiner states that Invention I is classified as class 707, subclass 523 and

that Invention III is classified as class 705, subclass 26. In regard to the classification for Invention I, there is no subclass 523 for class 707. Applicants assert that it is improper to rely upon a nonexistent classification to establish a separate status in the art. Furthermore, according to the Manual of Classification, the definition of class 707 is for data processing including database and file management or data structures. The claims of both group I and the claims of group III recite various aspects of data processing that could fall under class 707. Thus, the Examiner cannot rely upon this classification to establish a separate status in the art and serious burden.

The definition for class 705, subclass 26 is for electronic shopping. However, the claims of both group I and group III neither require nor exclude electronic shopping. The classification of group III as class 705, subclass 26 is not a very accurate classification. Furthermore, none of the claims either require or exclude electronic shopping. Thus, the Examiner cannot rely upon this classification to establish a separate status in the art and serious burden.

As shown above, the Examiner's classification of group I does not exist in the Manual of Classification and the Examiner's classification of group III is inaccurate. The Examiner has not established that truly separate classifications apply to the claim groups. Since the purported classifications are inaccurate and actually relate to all of the claims, the Examiner clearly cannot rely upon these flawed classifications to establish "a **serious burden** on the examiner if restriction is not required." See M.P.E.P. § 808. Since the Examiner's has failed to establish a "serious burden on the examiner if restriction is not required", Applicants' assert that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner's restriction requirement must be withdrawn.

In the Office Action of November 7, 2005, on pp. 11-12, the Examiner's only response to Applicants' traversal of the restriction requirement was to state: "Applicants arguments are not persuasive because Applicants have not argued that groups of inventions are not patentably distinct." However, it is the Examiner who has the burden

to state a proper restriction requirement. As shown above, the Examiner has failed to state a proper restriction requirement for numerous reasons. As such, Applicants respectfully request the removal of the restriction requirement and request examination of all pending claims 17-45.

## CONCLUSION

In light of the above remarks, Applicants request that the restriction requirement be withdrawn.

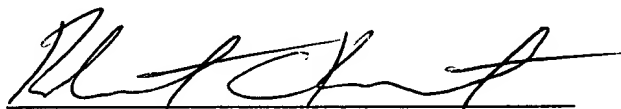
If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-52901/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☐ Other:

Respectfully submitted,



Robert C. Kowert  
Reg. No. 39,255  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert & Goetzel PC  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

Date: December 2, 2005